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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,693	01/19/2001	Daniel S. Sem	P-TB 4568	6461

23601 7590 12/30/2002

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE**  
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09/765,693	01/19/2001	SEM	P-TB 4568

EXAMINER	
Maurie Garcia Baker, Ph.D.	
ART UNIT	PAPER NUMBER
1639	13

DATE MAILED:

**Please find below a communication from the EXAMINER in charge of this application**  
Commissioner of Patents

Please see attached Notice of Non-Responsive Amendment.

### DETAILED ACTION

**Please note:** The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

#### *Notice of Non-Responsive Amendment*

1. The amendment filed on September 25, 2002 presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected (i.e. previously examined) invention for the following reasons.
2. Amended claims 15-19 and newly filed claims 37-41 are drawn to a different invention than the one currently under examination with respect to the new limitation that the common ligands are compounds that compete for cofactor binding. The claims previously under examination recited a “common ligand to a conserved site in a receptor family”. There was *nothing* present in the previously examined claims with respect to competitive binding. Thus amended claims 15-19 and newly filed claims 37-41 are different in scope and represent an invention that is independent or distinct from the invention originally claimed.
3. The limitation of “wherein said common ligand competes for cofactor binding” would require a completely different search due to different classification and/or divergent subject matter of such a “common ligand” and there is no expectation that the searches would be coextensive. Furthermore, art anticipating or rendering obvious a

“common ligand to a conserved site in a receptor family” would not necessarily anticipate or render obvious a common ligand that *competes* for cofactor binding, because they are drawn to different inventions that have different distinguishing features and/or characteristics.

4. The examiner recognizes that there does not appear to be originally filed claims that would represent the invention that now appears to be claimed; however, applicant is reminded of 37 CFR 1.142(b) and MPEP § 821.03. Since applicant has received an action on the merits for the *originally presented* invention, this invention has been constructively elected by original presentation for prosecution on the merits. Moreover, when one looks to the instant specification, it is clear that the originally claimed “common ligand to a conserved site in a receptor family” was *not* intended to include common ligands that compete for cofactor binding. For example, the definition of “common ligand” in the instant specification (page 8, lines 29-31) is as follows: “the term “common ligand” refers to a ligand that binds to a conserved site in a receptor family”.

5. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
December 29, 2002

A handwritten signature in black ink, consisting of stylized initials 'MB' followed by a horizontal line.

MAURIE GARCIA BAKER, Ph.D.  
PATENT EXAMINER